

Remarks/Arguments

In response to the Restriction Requirement mailed on September 19, 2006, an election is hereby made to invention I directed to claims 1-5 with traverse on the grounds that the patentably distinct species defined by the Office action are related and not distinct.

A requirement for restriction is permissible if: (1) the inventions, as claimed, are either independent or distinct; and (2) there would be a serious burden on the examiner if restriction is not required. (MPEP § 803). The inventions are independent if there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. (MPEP § 802.01). In determining whether the inventions are distinct, a showing must be made that they are either materially different, not obvious variants, or mutually exclusive.

In particular, MPEP 806.05(f), titled "Process of Making and Product Made," provides that a process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make another materially different product; or (B) that the product as claimed can be made by another materially different process.

The Office action states that the species are distinct because the products as claimed can be made by the coprecipitation and hydrothermal methods, and the process as claimed can be used to make a thermally conductive sintered ceramic body. The Office action stated that the claims to the aforementioned patent application can be separated into two distinct inventions, specifically claims 1–5 (invention I) and claims 6–20 (invention II). Claims 1-5 are generally directed to a compound of lithium nickel cobalt metal oxide, and claims 6-20 are generally directed to a process for making the compound of lithium nickel cobalt metal oxide.

It is the Applicants' contention that invention I and invention II are not distinct as stated under MPEP 806.05(f) for the following stated reasons.

Part A of MPEP 806.05(f) cannot be used to show invention I and invention II are two distinct inventions since invention II is an obvious process for making the product in invention I. In particular, claim 6 (and claims depended therefrom) can be an obvious process for making the product in independent claim 1 since claim 6 recites a general and straightforward method to make the product in claim 1.

Part B of MPEP 806.05(f) cannot be used to show invention I and invention II are two distinct inventions since no materially different process can be used to make the product in invention I. The broadest independent claim for invention 1 is a compound of lithium nickel cobalt metal oxide. Invention II recites methods for making this product. Other processes would require these steps in making the product in invention I; therefore those processes would not be materially different from the claimed processes.

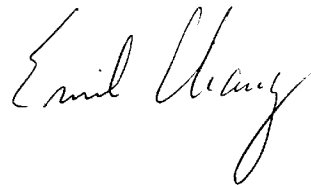
With respect to imposing a serious burden on the Examiner if restriction is not required, it has been shown that invention I and invention II are not mutually exclusive; therefore the basis for a serious burden on the Examiner is eviscerated. Furthermore, assuming the claims directed to invention I and to invention II are mutually exclusive, it still does not present a serious burden on the Examiner since both groups are closely related inventions. For instance, a search for prior art for both inventions can be performed in the same field or the same class. Any search for prior art that is applicable to one group would be applicable to the other group. Therefore, it is requested that the restriction requirement be reconsidered.

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For the above stated reasons, it is requested that the Restriction Requirement be reconsidered, and ultimately withdrawn. If withdrawal of the Restriction Requirement is declined, it is respectfully requested that reasons for insisting upon restriction are cited, MPEP 808.

If any matters can be resolved by telephone, applicant requests that the Patent and Trademark Office call the applicant at the telephone number listed below. The Examiner is thanked for his or her assistance.

Respectfully submitted,
Venture Pacific Law, PC

A handwritten signature in cursive script, reading "Emil Chang".

Emil Chang

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Reg. No. 37,593

Emil Chang
Venture Pacific Law, PC
(408) 988-9898x111 Office
(877) 256-3711 Fax
emil@vpaclaw.com